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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,086	02/07/2001	Rebecca Chinery	ATH 108 CON1	2259

7590 05/21/2003

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EXAMINER

CELSA, BENNETT M

ART UNIT

PAPER NUMBER

1639

DATE MAILED: 05/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

file copy

# Office Action Summary

Application No.  
09/779,086

Applicant(s)  
Chinery et al.

Examiner  
Bennett Celsa

Art Unit  
1639

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE one MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-30 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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### **DETAILED ACTION**

Claims 1-30 are currently pending.

**NOTE:** for future correspondences, the location of the present application is ART UNIT 1639

#### ***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-3, 9, 10 (and 16-30 in part), drawn to methods of treatment comprising administering an antineoplastic drug and an antioxidant, classified in class 514, subclass 706, for example.
  - II. Claims 4 (and 16-30 in part), drawn to a method to increase the nuclear localization of C/EBPbeta in a cell, comprising administering an antioxidant to the interior of a cell, classified in various classes/subclasses.
  - III. Claims 5 (and 16-22 in part), drawn to methods to inhibit the carboxymethylation of the catalytic subunit of protein phosphatase 2A comprising contacting methyltransferase with an antioxidant, classified in various classes/subclasses.
  - IV. Claims 6 (and 18-23 in part), drawn to method for identification of compounds that increase the cytotoxicity of antineoplastic agents comprising assessing the compound's ability to promote phosphorylation of Ser299,, classified in class 435, subclass 4.
  - V. Claims 7 (and 23 in part), drawn to methods for identification of compounds that increase the cytotoxicity of antineoplastic agents comprising assessing the ability

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of a compound to inhibit carboxymethylation of protein phosphatase 2A, classified in various classes/subclasses .

- VI. Claim 8, drawn to a peptide of the form X1-Arg-X2-Ser-X3, classified in class 530, subclass 300.
  - VII. Claim 11, drawn to a protein complex, classified in class 530, subclass 402.
  - VIII. Claims 12, 13 (and 24-30 in part), drawn to a method of treating abnormal cell proliferation in a host, classified in class 524, subclass 2.
  - IX. Claims 14 and 15, drawn to synthetic C/EBPbeta analogs, classified in various classes/subclasses .
2. The inventions are distinct, each from the other because of the following reasons:
3. Each of Inventions I-V and VIII is directed to a separate and distinct process. Each of the precesses are distinct both physically and functionally, require different steps and make or use different products. Inventions I and VIII are in vivo methods, comprising administering compositions to subjects. However, the methods of I and VIII use different compositions in their methods. Inventions II, III, IV and V appear to be drawn to in vitro methods which would make these inventions functionally and physically different from each of inventions I and VIII. Each of inventions II, III, IV and V required different steps and appear to require different reagents and/or are drawn to different method objectives and require different and separately burdensome manual/computer bibliographic/structural searches.

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4. Each of inventions VI, VII and IX are directed to a separate and distinct product. Each of inventions VI, VII and IX would be expected to have distinct morphological, functional, chemical and physical properties. It is possible to separately manufacture, use and sell the products as claimed. Furthermore, these products are patentable over each other and require different and separately burdensome manual/computer bibliographic/structural searches.

5. Inventions VIII and IX (drawn to C/EPBbeta proteins with substantial homology to C/EBPbeta) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the products may be used in a materially different process e.g. the polypeptides may be used to make antibodies, which represents a materially different process than the method of treatment of invention VIII. Furthermore, Inventions VIII and IX require different and separately burdensome manual/computer bibliographic/structural searches

6. Because these inventions are distinct for the reasons given above and

- a. have acquired a separate status in the art as shown by their different classification; and/or
- b. required different and separately burdensome manual and/or computer searches; and/or
- c. because these inventions have acquired a separate status in the art because of their recognized divergent subject matter,

restriction for examination purposes as indicated is proper.

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***Election/Restriction*** (Groups I-V and X)

7. This application contains claims (methods and compositions) directed to the following patentably distinct species of the claimed invention:

- a. antioxidant (groups I-IV: see e.g. claim 22 and disclosed species);
- b. antineoplastic agent (groups I, IV and V; see e.g. claim 23 species);
- c. C/EBP transcriptional factors (Group X) which comprise phosphate, phosphonate, phosphoroamidate compounds or analogues thereof ;

The abovementioned compositions (a-c) possess distinctly different structure, different physicochemical properties, are capable of separate manufacture and/or use and require different and nonoverlapping, separately burdensome, manual and/or computer searches, including structure, chemical name and bibliographic searches.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. This compound can be selected from the specification disclosure, including the examples. **In order to facilitate search a chemical structure corresponding to the single elected compound must be provided with the response.** Failure to provide a structure corresponding to the elected species, will be deemed nonresponsive.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable

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thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

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**General information regarding further correspondence**

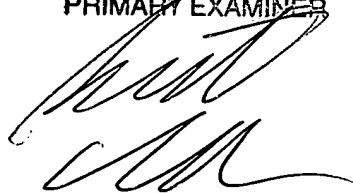
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Celsa whose telephone number is (703) 305-7556.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang (art unit 1639), can be reached at (703)306-3217.

Any inquiry of a general nature, or relating to the status of this application, should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Bennett Celsa (art unit 1639)  
May 19, 2003

BENNETT CELSA  
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read 'Bennett Celsa', is written over the printed name and title.